

REMARKS/ARGUMENTS

Status of the Claims

Upon entry of the present amendment, Claims 8-41 and 53-54 are pending. Claims 8 and 41 are amended. New claims 53-54 are added.

Claims 8 and 41 are amended to set forth that the MRE11 polypeptide has at least 95% sequence identity to SEQ ID NO:2 and has nuclease activity. Support is found, for example, on page 7, line 33 through page 8, line 8; and on page 8, lines 19-20.

Claim 8 is further amended to include the language of step (iii) from claim 41, as originally filed in claim 41.

New claim 53 sets forth that the MRE11 polypeptide is SEQ ID NO:2 and has nuclease activity. Support is found, for example, on page 7, line 33 through page 8, line 8; and on page 8, lines 19-20.

New claim 54 sets forth that the MRE11 polypeptide has at least 95% nucleic acid sequence identity to SEQ ID NO:1. Support is found, for example, on page 7, line 33 through page 8, line 8.

Rejection under 35 U.S.C. § 112, first paragraph, written description requirement

The Examiner has rejected claims 8-41 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants do not agree with the Examiner. However, in the interest in furthering prosecution, Applicants have amended independent claims 8 and 41 to set forth that the MRE11 polypeptide has at least 95% amino acid sequence identity to SEQ ID NO:2 and has nuclease activity. Therefore, the scope of the claimed methods utilizes a genus of MRE11 polypeptides having both structural and functional correlation.

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 8-40 under 35 U.S.C. §112, second paragraph for alleged lack of consonance between the preamble and the body of the claim. Applicants do not agree with the Examiner. However, in the interest of furthering prosecution, Applicants have incorporated the language of step (iii) from claim 41 as step (iii) in claim 8. Claim 41 was not included in this rejection. As amended, the body of claim 8 now interrelates with the preamble.

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(a), Lanson, Nucl Acids Res (2000) 28:2882 ("Lanson")

The Examiner has rejected claims 8-12, 14-17, 19, 27, 29, 32, 35, 38 and 39 under 35 U.S.C. § 102(a) as allegedly anticipated by Lanson. Applicants do not agree with the Examiner. However, in the interest of furthering prosecution, Applicants have incorporated the language of step (iii) from claim 41 as step (iii) in claim 8. Claim 41 was not included in this rejection. This element is not disclosed by Lanson. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(e), U.S. Patent Publ. 2002/0182586 ("Morris")

The Examiner has rejected claims 8-12, 14-17, 19, 23-30, 34-36 and 38-40 under 35 U.S.C. § 102(e) as allegedly anticipated by Morris. Applicants do not agree with the Examiner. However, in the interest of furthering prosecution, Applicants have incorporated the language of step (iii) from claim 41 as step (iii) in claim 8. Claim 41 was not included in this rejection. This element was not disclosed by Morris. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Appl. No. 10/026,331
Amdt. dated January 23, 2006
Reply to Office Action of October 21, 2005

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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